REMARKS

In the Notification of Non-Compliant Appeal Brief, the Office asserts that the Appeal Brief filed January 20, 2004 is defective. In particular, the Office asserts that two references (Hortin et al. (*Biochem. Biophys. Res. Comm.*, 141:326-333, 1986; hereafter "Hortin") and Huttner (*Annu. Rev. Physiol.*, 50:363-376, 1998)) cited in the Appeal Brief are not of record. The Office also asserts that Appellants, in stating that claims 24 and 25 do not stand or fall with claims 10 and 12-14 or each other, have "provide[d] insufficient explanation as to why or how the specification provides enablement or written description for any of these three 'genera' separately." The Office further asserts that Appellants indicate that the claims do indeed stand or fall together. Each of these matters is addressed below.

Hortin and Huttner are of record.

The Office errs in asserting that Hortin and Huttner are not of record. While the Office correctly notes that these references were not cited by the Office nor were cited by Appellants in an Information Disclosure Statement, copies of both references were submitted in conjunction with the Reply to Office action filed June 1, 1999. This is noted on page 7 of the Reply (emphasis added):

> As evidence of this assertion, applicants submit the attached publications by Hortin et al. (*Biochem. and Biophys. Res. Comm.* 141:326-333, 1986, e.g., see page 331, paragraph 3) and Huttner (*Ann. Rev. Physiol.* 50:363-376, 1988, e.g., see page 369, Table 2), both of which extensively discuss the amino acid consensus requirements for tyrosine sulfation.

Appellants also enclose a copy of the return postcard filed with this Reply (Exhibit A), which notes the inclusion of eight cited references and bears the USPTO stamp indicating receipt of the references. This Reply was acknowledged and entered by the Office in its action mailed August 31, 1999.

Accordingly, this basis for finding the Appeal Brief defective is erroneous, and Appellants request that the Office accept the concurrently filed Appeal Brief without further delay. Regardless, for the convenience of the Office, Appellants enclose copies of Hortin and Huttner.

The statements objected to by the Office have been deleted.

The Office also errs in asserting that the Appeal Brief filed January 20, 2004 is defective for providing insufficient explanation as to why or how the specification provides enablement or written description for any of these three genera separately. As an initial matter, former 37 C.F.R. § 1.192 indicated that appellants could state why claims are separately patentable. There was no requirement to show that the specification provides enablement or written description for the genera separately, as stated by the Office, and demonstrating claims to be separately patentable does not require doing so. While the Office cites former 37 C.F.R. § 1.192 as indicating that "merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable," the Office has, in its rejections under U.S.C. § 112, first paragraph, repeatedly stated that the size of the claimed genus, i.e., scope, is relevant to

patentability of the claims, in asserting that the claims encompass an essentially unlimited number of species. Appellants fail to see how the Office can now maintain that differences in the size of the claimed genera cannot form a basis for rendering the groups of claims separately patentable in view of these rejections. Accordingly, the Appeal Brief meets the requirements of former 37 C.F.R. § 1.192 by describing the differences in scope and providing descriptions of the three genera, thereby indicating why each group is separately patentable.

In addition, the Office misinterprets the statement (emphasis added), "On both issues presented above, however, the grouping of claims is the same." Appellants' statement indicates the claims are grouped into the same three groups for both issues, i.e., for both written description and enablement. Nowhere does this statement indicate, as the Office suggests, that all claims fall into a single group.

Nonetheless, while Appellants disagree with this basis for asserting noncompliance of the present Brief, to expedite prosecution Appellants have deleted the section entitled "Grouping of Claims" in the concurrently filed Appeal Brief, as 37 C.F.R. § 41.37 (which has replaced 37 C.F.R. § 1.192) does not require this section. This change removes the statements noted by the Office and accordingly renders the Office's assertions moot. Again, Appellants request the Office accept the concurrently filed Appeal Brief without further delay.

Other changes

In addition to the changes noted above, Appellants have amended the headings of the concurrently filed Appeal Brief to conform with 37 C.F.R. § 41.37. Specifically, the section "Summary of the Invention" has been renamed "Summary of Claimed Subject Matter," and the section "Issues" has been renamed "Grounds of Rejection to Be Reviewed on Appeal."

CONCLUSION

Appellants maintain that the Appeal Brief filed January 20, 2004 is in compliance with the rules and further maintain the concurrently filed Appeal Brief is likewise not in compliance. Accordingly, prompt acceptance of the concurrently filed Appeal Brief is requested. As this reply is filed within the one (1) month shortened statutory period set by the Office, Appellants believe no fee is due. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 22 June 2006

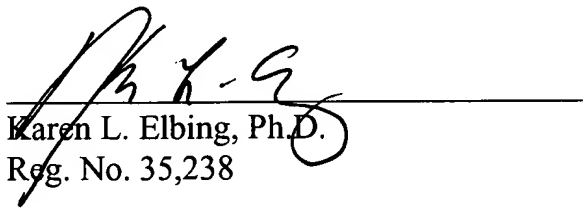

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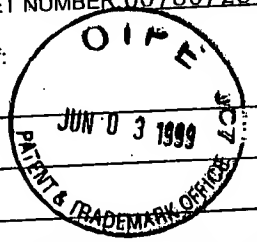
Exhibit A

PROSECUTION

PATENT
ATTORNEY DOCKET NUMBER: 00786/284002



The U.S. PTO date stamp sets forth the date of receipt of:

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☐ Transmittal Letter	Pages:	☐ Declaration & POA	Pages:
☐ Notice of Missing Parts	Pages:	☐ Assignment & Cover Sheet	Pages:
☐ Reply to Missing Parts	Pages:	☐ Change of Address	Pages:
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☒ Extension of Time	Pages: 1	☐ Preliminary Amendment	Pages:
☐ Notice of Appeal	Pages:	☐ IDS	Pages:
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